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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,172	01/29/2001	John L. Cartier	09221-P01	9721

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PERKINS, SMITH & COHEN LLP  
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BOSTON, MA 02108

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/772,172

Applicant(s)

CARTIER, JOHN L.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The Examiner has carefully considered Applicant's Declaration, amendments and remarks filed on 2/13/2004 and 11/20/2003. Applicant's amendments to claims 1, 3 and 4, and cancellation of claim 11 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### *Claim Objections*

4. The amendment filed 7/7/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

It is noted that Applicant still fails to point out any express or inherent support in the Specification for the amendments filed 7/7/2003 and "an integral, one-piece ... mat ... sealed on its surfaces and around its edges ... with said water-proof cover extending over both sides of the cover material" (Amendment, page 2). As such, the Examiner presumes that the basis of the amendment is the previously deleted phrase "sealed into one unit" in originally submitted claim 1, line 7 (see Amendment filed 3/6/2003).

Applicant is required to either point out the support in the Specification, or amend the corresponding Specification, so as to provide a clear support for the instantly claimed invention.

***Response to Amendment***

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onderak et al. (US 4403009) in view of cited Juneau (US 5100716), substantially for the reasons set forth in sections 5 and 6 of Paper No. 0817, together with the following additional observations.

The Examiner repeats (see Paper No. 0817, page 3) that Applicant fails to provide an express support in the Specification for the newly added elements in claim 1 as set forth above. In particular, since Onderak teaches that the wear (surface) layer is formed of polyvinyl chloride, which clearly reads on the same cover material of the instantly claimed invention, i.e., PVC (Specification, page 3). As such, it is believed that Onderak's floor covering is also inherently water-proof and non-adhering to ice.

In response to applicant's argument that "Onderak et al. and Juneau references are incompatible with each other" (Remarks, page 4, first paragraph), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Onderak and Juneau are directed to the field of endeavor, i.e., floor covering. As such,

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it would have been obvious to one of ordinary skill in the art to combine the teachings of Onderak and Juneau, Applicant's argument to the contrary notwithstanding.

With respect to newly submitted Declaration by Mr. Cartier stating that "one would grope in the dark to convert the multi-layered anti-skid mat of Onderak et al. into an ice breaker mat since the reference disclosed no such concept" (Declaration, page 2, point 7), the Examiner notes that Applicant's argument has been fully considered, but is not persuasive. In particular, Applicant argues the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to Applicant's argument that "Examiner's talk of optimization either of these references or a combination is no more than an obvious-to-try conjecture based on my disclosure of my invention" (Declaration, page 2, point 7), the Examiner notes that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to Applicant's argument that "I have searched housewares stores looking for anything resembling the disclosed product of the Onderak et al and Juneau

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patents and found nothing. The Onderak patent was filed in 1923. Twenty years later there was no realization by the patentees or anyone else building on their teachings" (Declaration, page 2, point 8), the Examiner notes that contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

While Applicant's alleged commercial success (Declaration, page 2, point 9) appears persuasive, the Examiner notes that Applicant fails to provide any evidentiary support for such success.

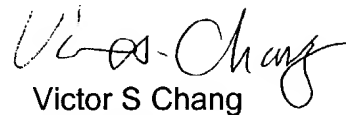
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Victor S. Chang". The signature is fluid and cursive, with the first name "Victor" and last name "Chang" being clearly legible.

Victor S Chang  
Examiner  
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3/18/2004